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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,305	10/31/2003	James Kaput	Kaput-100 US	5444

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EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,305

Applicant(s)

KAPUT, JAMES

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-4 and 16, in the reply filed on 15 November 2004 is acknowledged. The traversal is on the ground(s) that the inventions of Groups I-VIII are disclosed as being used together and that they cannot be sued separately. This is not found persuasive because the method of Group I does not require any food (Group 13), nor does the food of claim 13 require the array of claim 14.

2. The requirement is still deemed proper and is therefore made FINAL.

3. Claims 5-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 15 November 2005.

### ***Specification***

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

7. For convenience, claim 1, the only independent claim under consideration on the merits, is reproduced below.

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1. A method for identifying diet-regulated disease-associated polynucleotides comprising the steps of:

- (i) selecting at least two different inbred known genotypes (A and B), one of these genotypes (A) being more susceptible to a disease, and the other genotype (B) less susceptible to the same disease;
- (ii) dividing each genotype into two groups (A1 and A2 and B1 and B2);
- (iii) for each genotype, each group is fed a different diet (A1 is fed diet No.1 and A2 is fed diet No.2, and similarly for B1 and B2);
- (iv) measuring gene expression and comparing expression across the strains that differ in either genotype or in diet, but not in both;
- (v) analyzing the expression data so as to identify diet-regulated disease-associated genes.

8. For purposes of examination, the claimed method has been interpreted as encompassing the identification of “diet-regulated disease-associated polynucleotides” as found in any life form, be it plant or animal, including humans. In accordance with the claimed method, one is to select “at least two different inbred known genotypes.” The specification has not been found to provide an adequate written description of any “two different inbred known genotypes” as they occur in humans, much less any and all other life forms.

9. While one is to identify these polynucleotides on the basis of expression data, the specification fails to provide an adequate written description of how such polynucleotides, even if expressed differently, as in fact associated with a disease. Further, the specification does not provide an adequate written description as to how one would take into consideration such factors as race, gender, age, medications, radiation therapy, pregnancy, levels of exercise, as well as exposure to chemical or radiation stimuli.

10. It appears that applicant is attempting to satisfy the written description requirement of 35 USC 112, first paragraph, through obviousness. Obviousness, however, cannot be relied upon

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for satisfaction of the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* (Fed. Cir. 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (Fed. Cir. 1997) 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

Accordingly, and in the absence of convincing evidence to the contrary, the specification does not reasonably suggest that applicant was in possession of the invention at the time of filing.

11. For the above reasons, and in the absence of convincing evidence to the contrary, claims 1-4 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

12. Claims 1-4 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As set forth in *Enzo Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).... We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g.,

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*Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

13. It is well settled that one cannot enable that which they do not yet possess. As set forth above, the specification does not provide an adequate written description of the invention so as to reasonably suggest that applicant was in possession of the invention at the time of filing.

In order to practice the method of claim 2, for example, one is to compare "the diet-regulated disease-associated genes so identified [in claim 1] with an independently-derived set of diet-regulated and/or disease associated QTLs." The specification does not provide the requisite "independently-derived set of diet-regulated and/or disease associated QTLs" for any and all life forms, such that the comparison can be performed. The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001. As set forth in the decision of the Court:

" '[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.' *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); see also *Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) ('[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.').

\*\*\*\*\*

“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

“It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (Emphasis added)

14. For the above reasons, and in the absence of convincing evidence to the contrary, claims 1-4 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1-4 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



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17. Claim 1 is indefinite with respect to what constitutes “inbred” genotypes as it relates to any life form, be it plant or animal, including humans. Claims 2-4 and 16, which depend from claim 1, fails to overcome this issue and are similarly rejected.

18. Claim 1 is confusing as it relates to the benchmark to which “more” or “less” are being compared to. Additionally, it is unclear if the difference in susceptibility need be statistically significant.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "B. L. Sisson".

Bradley L. Sisson  
Primary Examiner  
Art Unit 1634

BLS  
07 March 2005